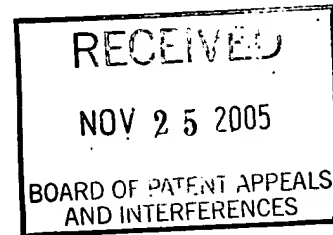


**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of : Paul C. Zimmer
Appeal No. : 2005-2375
U.S. Serial No. : 09/612,821
Filed On : July 10, 2000
For : PROMOTIONAL CALENDAR AND METHOD
Administrative Patent Judges : Charles E. Frankfort
John P. McQuade
Jeffrey V. Nase
Attorney Docket No. : ZMM-101



REQUEST FOR RECONSIDERATION

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Applicant requests reconsideration of the Decision of the Board dated October 25, 2005.

Applicant based this appeal on the rejection of claims 1-5 by the Examiner under 35 U.S.C.

§ 103(a).

While the Examiner referred to an alleged nonfunctionality in her Answer and in the Final Rejection, she also clearly stated that:

“... it would have been obvious to one of ordinary skill in the art at the time the invention was made to have printed the name of a person on each page to personalize the calendar . . .”

When applicant grouped claims 1-5 together, it was on the basis of that statement of the rejection, *i.e.*, if it was obvious to print the name of a person on each page of the Hallam calendar, applicant concedes this would render each of claims 1-5 unpatentable under 35 USC 103(a).

However, the Board's decision is not on its face based on such a finding. Rather, the decision is based on the nonfunctionality principle set out in In re Ngai, 367 F.3d 1336, 1338, 70 USPQ 1862, 1864 (Fed. Cir. 2004) and In re Gulack, 703 F.2d 1381, 1386, 217 USPQ 401, 404 (Fed. Cir. 1983). That is, that the recitation of printed matter constituted by the prominent imprint of a person's name should be disregarded in determining patentability under the holdings of these cases.

While the Board's opinion did state that the functionality of the claimed printed matter was the same as the printed matter in Hallam, nowhere does the opinion state that it would have been obvious to imprint each page of the Hallam calendar with a person's name in addition to the enterprise identifier.

This is thus a different basis for rejecting the claims than that put forth by the Examiner in making her rejection of claims 1-5. Indeed, the Board appears to in effect be holding that claims 1-5 are anticipated by Hallam under 35 U.S.C. § 102(b) if the imprinting of a Person's name is disregarded, in similar fashion of the rejection of the claim at issue in In re Ngai.

In view of the different basis for the affirmance, Applicant respectfully requests that he be allowed to withdraw the grouping of claims 1-5 together as to that rejection, and that the Board specifically consider claims 4 and 5 on their merits.

Claims 4 and 5 recite a method rather than a structure, and neither In re Ngai nor In re Gulack involve patentability of a method, but rather the weight to be accorded a printed matter limitation in a product claim.

In fact, in In re Ngai, a corresponding method claim was held by the PTO to be patentable even though the product claim was held not to be patentable cause the printed matter limitation was not given any weight. This was because the Court held that there was no functional relationship between the printed matter recited and the other claimed structure.

Method claims 4 and 5 recite a series of steps for promoting an enterprise to selected individuals by imprinting the name of the individual on each page of the calendar and also the enterprise name on each page to each day produce a mental association between the two in the mind of the individual to whom the calendar is distributed.

This promotional method is simply not remotely suggested in Hallam, and there is thus no basis for rejecting claims 4 and 5 under 35 U.S.C. § 103(a)

It is also respectfully urged that the Board again review In re Ngai. It will be found that that case held that there was no functional relationship between new printed instructions and a known test kit claimed in combination and thus the limitation should be disregarded in determining patentability. The printed instructions taught a new use for the kit but were not otherwise functionally related to the kit.

Here, the printed name of the person on each page is functionally related to the calendar since it brings the enterprise identifier and the name of the individual into a visual juxtaposition each day. Thus, this printed matter is functionally related to the calendar and should be given weight in a determination of patentability. As noted above, the Board opinion also states that the


printed matter recitation in the appealed claims has the same functional relationship to the calendar as depicted in Hallam. However, while this is true to the extent that they both individually create a visual impression every day, the function of daily creating an observed physical and visual juxtaposition of the person's name with the imprinted enterprise symbol is not "depicted in Hallam" since there is no such juxtaposition of these two different categories of printed matter in Hallam.

Accordingly, a functional relationship between the calendar and the imprint of a person's name exists and should be given patentable weight, and this functional relationship of creating a daily visual juxtaposition between the imprinted enterprise identifier and personal name imprint confers patentability on claims 1-5.

Respectfully submitted,

Date: November 24, 2005

By:



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CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8(a)

It is hereby certified that this correspondence, along with any items referred to as being attached or enclosed, is being transmitted to the United States Patent and Trademark Office, Facsimile No. 517-273-0052, on November 24, 2005

By:


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